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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/809,216

Filing Date: March 25, 2004

Appellant(s): KAWA ET AL.

Thomas F. Presson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 May 2009 appealing from the Office action mailed 12 December 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

- 1) Claim 1 was rejected under 35 U.S.C. §112, six paragraph.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

EP 0855714 A2	Yasuda et al	7-1998
WO 99/48096	Kelly et al	9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6, 9, and 11-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For your reference, below is a section from MPEP 2105 :

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se
Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-

Art Unit: 2178

readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(b), below. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim.

Claims 1-6, 9, and 11-12 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to be claiming "software systems" i.e. systems without hardware indication, which is computer program per se. Since the computer program is not embodied on a tangible computer readable medium, they appear non-statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9 and 11-14 remain rejected under 35 U.S.C. 102(b) as being anticipated by Yasuda et al (EP 0 855 714 A2, published 7/29/1998).

As per independent Claim 9, Yasuda et al discloses an apparatus comprising:

- acquiring means for acquiring reproduction control information, which is created in accordance with edit point information describing an edit point set for data and which serves to control reproduction of said data; and reproducing means for reproducing said data in accordance with said reproduction control information acquired by said acquiring means. (Column 5, line 45-58: Discloses a storage medium comprising picture data as well as reproduction information which is read out by a read-out unit (acquiring data), wherein this information would be used to reproduce data such discloses in FIG 3(A-C), and FIG 6.)
- determining means and selecting means for use when said reproduction control information includes information for indicating as a reproduction object data, which are relocated by an information creating apparatus for creating said reproduction control information and which are in proximity of said edit point (Column 5, lines 45-50: Discloses coded data string to reproduced, wherein the coded data is selected and reproduced (Column 6, lines 2-9,16-23; FIG 3,8; Column 9, lines 5-46)
- determining means determines a location at which to start reproducing said data accordance with said reproduction control information; (Column 5, lines 52-54: reproduction start point)

Art Unit: 2178

- selecting means selects a decoder for reproducing said data; and (FIG 5;
Column 6, lines 2-9, 33-49: Discloses a decoding unit is presented. During operation, the method uses (selects) the decoder presents to perform its functionality.)
- wherein said reproducing means reproduces said data based on said reproduction control information, on the starting location determined by said determining means, and on said decoder selected by said selecting means.
(Column 5, lines 2-9, 16-24, 29-49) (Examiner meant to state "Column 6" in previous action)
- wherein the selecting means selects a decoder from a plurality of decoders in accordance with the reproduction control information which includes designation information. (Col 6, lines 39-48, FIG 7: Decoding unit contains a plurality of decoders wherein a decoder is selected from the plurality of decoder. The information contains designation information of the designated start point and end point (Col 5, line 51-55))

As per dependent Claim 11, Claim 11 recites similar limitations as in Claim 9, and is similar rejected under rationale.

As per dependent Claim 12, Claim 12 recites similar limitations as in Claim 9, and is similar rejected under rationale.

As per independent Claim 13, Claim 13 recites a method for performing the method of Claim 9, and is similarly rejected under rationale.

As per independent Claim 14, Claim 14 recites a program for performing the method of Claim 9, and is similarly rejected under rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

. Claims 1, and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda et al (EP 0 855 714 A2, published 7/29/1998) in further in view of Kelly et al (WO 99/48096, published 9/23/1999).

As per independent Claim 1, Yasuda et al discloses a apparatus comprising:

- first acquiring means for acquiring edit point information and describing an edit point set for said data; creating means for creating reproduction control information in accordance with said edit point information acquired by said first acquiring means, said reproduction control information resulting from an editing process based on said edit point and serving to control reproduction of said data. (Column 5, line 45-58: Discloses a storage medium comprising picture data as well as reproduction information which is read out by a read-out unit (acquiring data), wherein this information would be used to reproduce data such as disclosed in FIG 3(A-C), and FIG 6.)

- creates said reproduction control information including information for indicating said data relocated by said relocating means as a reproduction object (Column 5, lines 45-50: Discloses coded data string to reproduced, wherein the coded data is selected and reproduced (Column 6, lines 2-9,16-23; FIG 3,8; Column 9, lines 5-46)
- relocating means for relocating data in proximity in proximity of said edit point and determines the location at which to create data in proximity of the edit point in accordance with the result of the determining means. (Column 5, lines 52-54: Contains a data on a production start point and end point for relocating (reproduction) data. In addition, when reproducing data, data is being created.)

However, Yasuda et al fails to discloses determining means for determining whether it is possible for said reproducing apparatus to reproduce in real time said data resulting from said editing process; and relocating means for relocating data in proximity of said edit point if said determining means determines that it is impossible for said reproducing apparatus to reproduce in real time said data resulting from said editing process. However, Kelly et al discloses a system recording real time information signal for editing (Page 1, lines 1-5) wherein on Page 5, lines 15-35, Kelly et al discloses on how their system function when determining using real time data and wherein if the data is not real data.

It would been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Yasuda et al's method with Kelly et al's method since Kelly

et al's method would have provided the benefit for a real time information signal recorded earlier on the record carrier can be reproduced without any interruption.

As per dependent Claim 3, Yasuda et al discloses designating a decoder.
(Column 6, lines 2-9; 29-49, FIG. 5: Discloses being delivered to a decoder, and its functionality)

As per dependent Claim 4, Yasuda et al discloses determining a location at which said reproducing apparatus reproducing said data, and information for designating the starting location determined by said determining means. (Column 5, lines 52-55; Column 8, lines 48-50)

As per dependent Claim 5, Yasuda et al discloses designating said starting location by said determining means using address information being processed by said reproducing apparatus. (Column 8, line 48 – Column 9, line 4: Containing the data for the starting point would include the address of the location within the signal.)

As per dependent Claim 6, Claim 6 recites similar limitations as in Claim 1 and is similarly rejected under rationale. Furthermore, Yasuda et al discloses an apparatus further disclosing comprising second acquiring means which, if said data are constituted by pictures, then acquires picture information about said pictures; wherein said creating means creates said reproduction control information in accordance with said picture information acquired by said second acquiring means. (Column 5, line 30- Column 6, lines 23: Discloses coded data string consisting of aforementioned I pictures, B pictures, and P pictures wherein a read-out unit reads (acquires) the data from the storage medium wherein reproduction is obtained that used for editing the picture data.)

As per independent Claim 7, Claim 7 recites a method for performing the apparatus of Claim 1 and is similarly reject under rationale.

As per independent Claim 8, Claim 8 recites a program for performing the apparatus of Claim 1 and is similarly reject under rationale.

(10) Response to Argument

a) On page 11, in regards to Appellant's arguments of the 35 USC 101 rejections to Claims 1, 3-6, 9, and 11-12, Appellant states that the claims are apparatus claims and therefore comply with the statutory subject matter requirement. However, the Examiner disagrees.

Claims 1-4 disclose an apparatus; however, the claim language in the claims failed to disclose or mention what is included in an apparatus at all. Thus, the claims fail to disclose if this apparatus indicates any hardware; therefore, the apparatus is representing a data structure resulting in the claims being viewed as software in view of data structures. The use of the word "apparatus" does not inherently mean that claim is directed to a physical machine. Therefore, the claims, themselves, lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory. They are, at best, functional descriptive material per se. Thus, in regards to claims 1-4, and 9-12, the claims, as written, appear to be claiming

“software systems” i.e. systems without hardware indication, which is computer program per se. The claims as written do not recite any hardware indication.

b) On page 12, in regards to Claims 1 and 3-8 rejected under 35 USC 103(a), Appellant argues that Yasuda and Kelly (precisely Kelly) fails to teach or suggest the limitation “determining means for determining whether it is possible for said reproducing apparatus to reproduce in real time said data resulting from said editing process”. Appellant argues that Kelly fails to teach or suggest how to determine whether the reproducing process itself is able to produce real-time data or not. However, the Examiner disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., how to determine whether the reproducing process itself is able to produce real-time data or not) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Based on the claim language of the claim limitation, it clearly states “determining means for determining whether it is possible...” The claim limitation does not disclose how it determines if it can produce real-time data, just it determines if it can or cannot to produce real-time data. Therefore, Kelly discloses the reproduction and editing of real-time information on/from a disc like record carrier (title), enables simultaneous reading and writing of real-time information from/onto a disc-like record carrier, and to enable

reproduction and seamless editing. (abstract, lines 1-3, 6-7) In addition, Kelly discloses the ability to recognize the difference between real-time data and non-real-time data wherein the disc system can or cannot guarantee a maximum sustainable bit rate for reading and/or writing based on if the data is real time or not, respectively. (Page 5, lines 15-35) In other words, Kelly et al discloses on how their system function when determining using real time data and wherein if the data is not real data. Therefore, since Kelly's invention discloses a method of reproducing and editing of real time data, it's already determined that it is possible of reproducing real-time data since it performing the functionality reproducing real-time data. Thus, Kelly teaches the limitation.

It would been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Yasuda et al's method with Kelly et al's method since Kelly et al's method would have provided the benefit for a real time information signal recorded earlier on the record carrier can be reproduced without any interruption.

c) On pages 12-13, in regards to Claims 1 and 3-8 rejected under 35 USC 103(a), Appellant argues Yasuda and Kelly fail to teach or suggest the limitation "relocating means for relocating data in proximity of said edit point if said determining means determines that it is impossible for said reproducing apparatus to reproduce in real time said data resulting from said editing process." First, Appellant argues that Yasuda does not contain data that need to be produced since Appellant submits that address, period of time and the like are not the data that need to reproduce as claimed

in relocating data in proximity of said edit point. Second, Appellant argues that producing data and relocating data are different matters. However, the Examiner disagrees.

According to the claim language of the claim limitation, it says relocating data in proximity of edit point. However, the claim limitation nor Appellant's argument disclose what this data or what an edit point exactly is per se, other than being within the data being within proximity of a edit point. Column 5, lines 52-54 discloses reproduction information on the reproduction interval contain a data on a reproduction start point and end point, or interval length, wherein the data mentioned is in reference to the data disclosed in Col 5, lines 45-49 wherein the data is a coded data string consisting I, B, P pictures. In addition, reproduction information on a reproduction interval of the coded data constituting this coded data string. Thus, based on its respective reproduction intervals, (Col 5, lines 56-57) this coded data is selected and reproduced (Column 6, lines 2-9,16-23; FIG 3,8; Column 9, lines 5-46). Therefore, Yasuda disclosing reproducing data in proximity of a edit point (interval). Furthermore, Appellant and the claim limitations failed to clearly state the differences between relocating and reproducing of how relocating is not the same as reproducing. Relocating is moving data from one location to another location. Reproducing is copying data from one location and moving the copied data to another location. Thus, in essence, both relocating and reproducing are moving data from one location to another. Therefore, reproducing is a form of relocating data. For that reason, Yasuda and Kelly disclose the limitation.

d) On pages 12-13, in regards to Claims 1 and 3-8 rejected under 35 USC 103(a), Appellant merely states Yasuda and Kelly fail to disclose or suggest "wherein said creating means creates said reproduction control information including information for indicating said data relocated by said relocating means as a reproduction object, and wherein said relocating means for relocating data in proximity in proximity of said edit point and determines the location at which to create data in proximity of the edit point in accordance with the result of the determining means." However, the Examiner disagrees.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Appellant's argument fails to disclose how the cited art is silent or doesn't teach on the limitation since the Appellant does not fully describe the differences that involve any supporting evidence from the specification stating or describing the limitation, or how the cited art is specifically different. For example, the Examiner respectfully states that the Applicant fails to clarify, based on the claim language and the claim limitations, how Yasuda fails to teach the cited limitation. Therefore, Examiner respectfully incorporates the cited response of the previous argument (argument c)) disclosed just above in response to this argument (argument d)) since this argument recites similar limitations as the limitation(s) previous discussed associated with argument c). In addition, Col 5, lines 47-55 and Col 1, lines 14-17 of Yasuda discloses the reproduction information is

made/presented/written that contains reproduction start point, reproduction end point, or reproduction interval length of the coded data constituting its corresponding coded data string. Thus, Yasuda discloses the creation of reproduction information needed for indicating data for reproducing (relocating).

e) On page 14, in regards to Claims 9 and 11-14 are rejected under 35 USC 103(a), Appellant merely states Yasuda and Kelly fail to disclose or suggest "determining means and selecting means for use when said reproduction control information includes information for indicating as a reproduction object data, which are relocated by an information creating apparatus for creating said reproduction control information and which are in proximity of said edit point." However, the Examiner disagrees.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Appellant's argument fails to disclose how the cited art is silent or doesn't teach on the limitation since the Appellant does not fully describe the differences that involve any supporting evidence from the specification stating or describing the limitation, or how the cited art is specifically different. For example, the Examiner respectfully states that the Applicant fails to clarify, based on the claim language and the claim limitations, how Yasuda fails to teach the cited limitation.

Therefore, Examiner respectfully incorporates the cited responses of the previous arguments (arguments c) and argument d)) disclosed above in response to this argument (argument e)) since this argument recites similar limitations as the limitation(s) previous discussed associated with arguments c) and d).

f) On pages 14-15, in regards to Claims 9 and 11-14 are rejected under 35 USC 103(a), Appellant states Yasuda does not select a decoder based on any kinds of control information as disclosed in the present invention in Figures 26 and 31 where a decoder is selected from a plurality of decoders in accordance with the reproduction control information which includes designation information such as the description [decoder = "0"] (Fig. 26) and the preDecBegin attribute (Fig. 31). However, the Examiner disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., decoder is selected from a plurality of decoders in accordance with the reproduction control information which includes designation information such as the description [decoder = "0"] (Fig. 26) and the preDecBegin attribute (Fig. 31).) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Based on the claim language of the claim limitation, it clearly states "wherein the selecting means selects a decoder from a plurality of decoders in accordance with the

reproduction control information which includes designation information". The claim language does not state that the reproduction control information includes designation information such as description [decoder = "0"] (Fig. 26) and the preDecBegin attribute. The claim language actually discloses the reproduction control information includes designation information wherein designation information could be any information since the limitation fails to specifically disclose what the designation information is. In addition, the claim language fails how a decoder is specifically selected from a plurality of decoders. Even though the limitation states in accordance with reproduction control information includes designation information, it is unclear, based on the claim language, how or if at all, the reproduction control information that includes designation information actually selects a decoder, other than providing (thus in accordance) reproduction information to the decoder for decoding data. Therefore, Yasuda discloses a decoding unit that when the unit is used during operation, the decoder presented is used (selected). Furthermore, the decoding unit contains a plurality of decoders wherein a decoder is selected from the plurality of decoders when data is being reproduced. (Col 6, lines 39-48, FIG 7) During the reproducing process, the coded data corresponding to the respective reproduction intervals (start and end points) are successfully decoded. (Col 5, line 51-55)) Thus, the reproduction provides designation information on what interval of the coded data string for reproduction during the decoding process and the decoders used (selected). (Col 6, lines 2-9, 16-24, 29-49; Col 6, line 49 –Col 7, line 41; FIG 7) Therefore, Yasuda discloses the limitation.

All other arguments on page 15 are referring to the dependent claims and parallel claims which are in reference to the topics above, thus the rationale above can be used to respond to the similar arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/David Faber/

Examiner, Art Unit 2178

Conferees:

Supervisory Patent Examiner, Art Unit 2178

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Application/Control Number: 10/809,216
Art Unit: 2178

Page 19